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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,563	04/25/2001	Mika Juhani Gronroos	297-010153-US(PAR)	7497
7590	08/16/2005		EXAMINER	
Clarence A. Green Perman & Green 425 Post Road Fairfield, CT 06430			CHIANG, JACK	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/842,563	Applicant(s) GRONROOS ET AL.	
	Examiner Jack Chiang	Art Unit 2642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/6/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) 6-27, 30-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

CLAIMS

Art Rejection

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martensson (EP 0414365 A2) in view of Norman (WO 98/09414).

Regarding claim 1, Martensson shows:

A body part (2) constructed to house at least a portion (i.e. 3) of a telephone apparatus;

A sleeve-like grip part (7) adapted to be held by a user during use and constructed to receive the body part (2) for longitudinal slidable movement of the body part (2) on the grip part (7), between a retracted position (fig. 2) and an extended position (fig. 1);

An actuator mechanism (fig. 5) coupled between the grip part (7) and the body part (2) for effecting the longitudinal slidable movement of the body part (2) relative to the grip part (7) between the retracted position (fig. 2) and the extended position (fig. 1);

A locking mechanism (15) for detachably locking the body part (2) into the grip part (7) in the retracted position (fig. 1);

A user-actuable releasing actuator (14) for releasing the locking mechanism (15), a longitudinal slidable movement of the body part (2) moves said body part upwards from

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the retracted position to an extended position where the body part (2) is above the grip part (7).

Martensson differs from the claimed invention in that the user-actuatable releasing actuator (14) is mounted in the body part (2) instead of the grip part (7) for releasing the locking mechanism.

However, Norman teaches providing a user-actuatable releasing actuator (96) which is mounted in the grip part (12) for releasing the locking mechanism.

Hence, the concept of providing such releasing actuator is well taught by both Martensson and Norman. In fact, the types of locking in both Martensson and Norman should be substantially the same. The location of the releasing actuator is dictated properly by the location of the latch (such as fig. 7 in Norman).

Therefore, it would have been obvious for one of ordinary skill in the art to use Martensson as it is, or to modify Martensson by putting the latch and its release actuator in the grip part (lower part of the phone) as taught by Norman. This simply can be considered as a variation of Martensson because whether this actuator (and its latch) is replaced in the body part (upper part) as shown in Martensson, or is replaced in the grip part (lower part) as shown by Norman, its function would remain substantially unchanged.

Regarding claims 2 and 28, the combination of Martensson and Norman shows:

The grip part (7 in Martensson) having first and second side surfaces (two sides), and the actuator (see rejection in claim 1);

The body part (2 in Martensson) having a majority of the electrical parts, and the grip part (7) having surfaces configured for a single-hand grip.

3. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable the combination of Martensson and Norman over in view of the admitted prior art disclosed in pages 8-9 of the present application.

Regarding claims 3-5, the combination of Martensson and Norman shows the release actuator (see comments in claim 1).

The combination of Martensson and Norman differs from the claimed invention in that it shows one release actuator instead of two.

However, the concept of providing a release actuator is well taught by the combination of Martensson and Norman. Further, it is well known that two release actuators can be provided for a locking mechanism as it is disclosed in pages 8-9 of the present application. Also, from pages 8 and 12 of the present application, it shows one release actuator and suggests that two release actuators can be used. In other words, there is no teaching of criticality for one actuator over two actuators.

Hence, it would have been obvious for one skilled in the art to use the combination of Martensson and Norman as it is, or to modify the combination of Martensson and Norman with two actuators as it is known in the art. This simply can be considered as a variation of the combination of Martensson and Norman as long as the basic concept of providing the release actuator is substantially unchanged. This also can be considered as duplicating parts of the combination of Martensson and Norman device (St. Regis Paper Co. v Bemis Co., 193 USPQ 8, 7th Cir. 1977).

ARGUMENT

4. In response to the remarks (pages 2-7) filed on 6/6/05, in pages 2-3, applicant has requested the election requirement to be reconsidered, and argued that the examiner's position would seem to rule out depending claims in general.

The examiner disagrees. There are many depending claims which are examined in this application. A telephone has many features which are classified in many different classes and subclasses. In the present case, it is believed that various distinct inventions were claimed and therefore required a restriction. For instance, claim 30 recited a display and claim 31 recited an antenna, these involve at least two different classes. Further, they are distinct species, one reason is because the antenna is not a further limitation of the display, a search for the antenna is not required for the search of the display. In conclusion, the restriction is proper and made final.

In pages 3-4, applicant argues that Martensson is not a proper reference because the merger of corporate assets, ... commonly owned by Nokia ... prior art based on 35 USC 102(e).

The examiner disagrees. Martensson is a proper reference because it has a publication date of 2/27/91 which falls into a 35 USC 102(b) time frame, not the 35 USC 102(e) as applicant argues.

In pages 4-5, about the combination of Martensson and Norman, applicant first argues that Norman does not use a sleeve-like grip part.

The examiner agrees. However, the sleeve-like grip part is already taught by Martensson. The examiner is not relying on Norman to teach the sleeve.

Applicant further argues that Norman's grip part 12 is actually the body of the telephone. First, applicant is entitled to interpret Norman's housing in anyway he wants. Second, the fact is Norman's grip part 12 is used for hand grip and having a releasing actuator, this is the concept that the examiner is relying on to modify Martensson's grip part to incorporate the releasing actuator. Third, although Norman's grip part 12 has many other features, that does not prevent it to teach the above concept. This same analysis is also applied onto applicant's grip part which also has many other features, such as a microphone and a connector etc. In conclusion, both Norman's and applicant's grip part have other electronic features, that does not exclude them from functioning as a grip part. Further, it is believed that the reasons for combining Martensson and Norman have well established as discussed in the rejections and argument above.

In pages 6-7, about claims 4-5, there is no specific argument about these claims, see rejection above.

5. Applicant's arguments filed 6/6/05 have been fully considered but they are not persuasive. See comments above.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the


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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 571-272-7483. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jack Chiang
Primary Examiner
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